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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,450	12/20/2001	Saverio Carl Falco	BB1126 USDIV	1501

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EXAMINER

SAIDHA, TEKCHAND

ART UNIT PAPER NUMBER

1652

DATE MAILED: 01/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/027450

Applicant(s)

falco et al

Examiner

T. Sardha

Group Art Unit

1652

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE One MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 1/22/02.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 27-40 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 27-40 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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***RESTRICTION***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 27-35 & 39-40, drawn to nucleic acid [Zea mays, SEQ ID NO : 46] encoding a polypeptide of SEQ ID NO : 47 having leuD activity, vector, host cell and method of making the protein, classified in class 435, subclass 232.
  - II. Claims 27-35 & 39-40, drawn to nucleic acid [Oriza sativa, SEQ ID NO : 48] encoding a polypeptide of SEQ ID NO : 49 having leuD activity, vector, host cell and method of making the protein, classified in class 435, subclass 232.
  - III. Claims 27-35 & 39-40, drawn to nucleic acid [Glycine max, SEQ ID NO : 50] encoding a polypeptide of SEQ ID NO : 51 having leuD activity, vector, host cell and method of making the protein, classified in class 435, subclass 232.
  - IV. Claims 27-35 & 39-40, drawn to nucleic acid [Triticum aestivum, SEQ ID NO : 52] encoding a polypeptide of SEQ ID NO : 53 having leuD activity, vector, host cell and method of making the protein, classified in class 435, subclass 232.
  - V. Claims 36-38, drawn to transgenic plant comprising the recombinant DNA construct having Zea mays DNA of SEQ ID NO : 46, a seed [800/298]..comprising the Zea mays DNA and a method of producing such a plant, classified in class 800, subclass 278.
  - VI. Claims 36-38, drawn to transgenic plant comprising the recombinant DNA construct having Oriza sativa DNA of SEQ ID NO : 48, a seed [800/298]..comprising the

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Oriza sativa DNA and a method of producing such a plant, classified in class 800, subclass 278.

VII. Claims 36-38, drawn to transgenic plant comprising the recombinant DNA construct having Glycine max DNA of SEQ ID NO : 50, a seed [800/298]..comprising the Glycine max DNA and a method of producing such a plant, classified in class 800, subclass 278.

VIII. Claims 36-38, drawn to transgenic plant comprising the recombinant DNA construct having Triticum aestivum DNA of SEQ ID NO : 52, a seed [800/298]..comprising the Triticum aestivum DNA and a method of producing such a plant, classified in class 800, subclass 278.

2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I-IV are patentably distinct from each other. The nucleic acids of Group I-IV (or DNAs) encoding the polypeptide of SEQ ID NO : 47, 49, 51 & 53 are independent chemical entities and require different sequence searches and encode polypeptides of varying activity levels. They are chemically and structurally distinct molecules. Each of the DNA sequences encode a polypeptide which is structurally, biologically and chemically distinct. Therefore, Inventions I-IV are patentably distinct.
4. Inventions V-VIII are patentably distinct from each other. The transgenic plant or seed comprising the recombinant DNA construct of different structure of SEQ ID NO : 47, 49, 51 & 53;

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are physically, chemically and biologically distinct from each other; and are subject to separate manufacture and sale from each other.

5. Inventions I-IV and V-VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the nucleic acids of Group I-IV (or DNAs) encoding the polypeptide of SEQ ID NO : 47, 49, 51 & 53, as claimed in Group I-IV, can be used in a materially different process other than the methods of producing transgenic plants/seeds of diverse genotype of Group V-VIII, such as in the recombinant expression of the polypeptide.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventor ship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tekchand Saidha (Ph.D.) whose telephone number is (703) 305-6595. The examiner can normally be reached on Monday-Friday from 8:15 am to 4:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804. The fax phone number for this Group in the Technology Center is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Tekchand Saidha  
Primary Examiner  
Art Unit 1652  
January 20, 2003